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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/686,322 | 10/14/2003 | Gilbert Chu | STAN-277 | 7388 |
| 77974 | 7590 | 08/19/2008 | EXAMINER | |
| Bozicevic, Field & Francis LLP | | | CALAMITA, HEATHER | |
| Stanford University Office of Technology Licensing | | | | |
| 1900 University Avenue | | | ART UNIT | PAPER NUMBER |
| Suite 200 | | | | 1637 |
| East Palo Alto, CA 94303 | | | | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 08/19/2008 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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AUG 19 2008

In re Application of :
Chu : Decision on Petition
Serial No.: 10/686,322 :
Filed : 14 October 2003 :
Attorney Docket No.: STAN-277 :
:

This letter is in response to the Petition filed on 3 December 2007 to request review of the restriction requirement.

BACKGROUND

This application was filed under 35 USC 111(a) and as such is eligible for US restriction practice under 35 USC 121 and chapter 800 of the MPEP.

On 16 May 2006, the examiner placed claims 1-46 into three groups for restriction and also required election of a single sequence for any of the three groups elected.

On 16 June 2006, applicants elected Group I primary cells without traverse. Applicants traversed the requirement to elect a single sequence. Concurrent with the election, applicant amended their claims from requiring "any gene" to requiring "at least 10 sequences."

On 28 February 2007, the examiner mailed out a letter requesting an election of a single sequence. Applicants elected Cyclin B and the ten top ranked sequences in Table 3 with traverse, as follows:

Should the Examiner require an election of ten sequences, Applicants elect the ten top-ranked sequences as set forth in Table 3: Cyclin B; ATP synthase, H⁺ transporting, mitochondrial F1 complex, delta subunit; CDC28 protein kinase 2; formin-binding protein 17; ribosomal protein S9; phorbolin-like protein MDS019; tumor necrosis factor (ligand) superfamily, member 7; RNA helicase; disrupter of silencing 10; and heat shock 27kD protein 1.

On 1 June 2007, the examiner considered the traversal and made the restriction requirement final. Claims 1-6, 9-12, 17-18 and 21-33 were under examination. Claims 8, 14 and 20 were

withdrawn from examination. Claims 1-6, 10-12 and 26-30 were rejected under 35 USC 102(b). Claim 15, 17-18 and 22-25, 31-33 were rejected under 35 USC 103(a).

This petition was filed on 3 December 2007, along with an amendment to the claims and a response to the Office action.

DISCUSSION

This file history and petition have been carefully considered.

The petition requests that the restriction requirement to elect a single sequence be withdrawn.

It is noted that the original restriction requirement was written in reference to the original claims that read upon any (one) gene. In contrast, the second restriction requirement, the first Office action on the merits and this decision should have and now must address (1) the amended claims which require at least 10 sequences and (2) the election of the ten top ranked sequences from Table 3.

The change from a single subcombination to a combination of 10 elements may be considered as shift in invention. MPEP 819 states:

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter.

However, because the amendment to the claims and election was presented prior to the first Office action on the merits, in an effort to expedite prosecution in this particular application, the petition decision will address currently pending claims along with the election of ten sequences.

The petition also states: "all of the sequences recited in the present application are publicly available and known in the prior art." However, the claims are not directed to the sequences, but to method of using the sequences. If applicant is attempting to state that the methods of using any combination of the sequences would be obvious one over the other, it is noted that applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

DECISION

For these reasons, the petition is **GRANTED**.

The restriction requirement to elect a single sequence has been withdrawn.

The election of the combination of top ten ranked sequences shown in Table 3 is acknowledged:

Should the Examiner require an election of ten sequences, Applicants elect the ten top-ranked sequences as set forth in Table 3: Cyclin B; ATP synthase, H⁺ transporting, mitochondrial F1 complex, delta subunit; CDC28 protein kinase 2; formin-binding protein 17; ribosomal protein S9; phorbolin-like protein MDS019; tumor necrosis factor (ligand) superfamily, member 7; RNA helicase; disrupter of silencing 10; and heat shock 27kD protein 1.

The application will be forwarded to the examiner for consideration of the papers filed 3 December 2007 and preparation of an Office action consistent with this decision.

Should there be any questions regarding this decision, please Quality Assurance Specialist/Program Manager Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 571-273-8300.



George Elliott
Director, Technology Center 1600